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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/517,711	12/10/2004	Stefan Bogl	CBZ-1266	4636

22827 7590 01/26/2007  
DORITY & MANNING, P.A.  
POST OFFICE BOX 1449  
GREENVILLE, SC 29602-1449

EXAMINER
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MCDONALD, SHANTESE L

ART UNIT	PAPER NUMBER
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3723

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
2 MONTHS	01/26/2007	PAPER

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/517,711  
Filing Date: December 10, 2004  
Appellant(s): BOGL, STEFAN

MAILED  
JAN 26 2007  
Group 3700

Stephen E. Bondura  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 10/23/06 appealing from the Office action mailed 8/1/06.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

DE 19753705		6-1999
5,209,020	Feisel	5-1993

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 102***

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 21,25-27,29-32 and 40 are rejected under 35 U.S.C. 102(b) as being anticipated by DE 19753705.

DE 19753705 teaches a method for producing a precise prefabricated concrete part in the form of a plate, 4, for a fixed track for a rail guided vehicle, comprising using a grooved roller, 30, or a plurality of grooved rollers, to grind connection surface to an actual dimension of the connecting surface, for add on elements, 5, of the fixed track into the prefabricated concrete part at relevant points, 1, along the concrete part, the grooved roller defining the connection surface to desired predetermined dimensions. DE '705 also teaches positioning the prefabricated concrete part in a defined position, free of tension, corresponding to its subsequent installed position for the grinding

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process, (translation pg. 26, lines 11-12), and determining a target dimension of the connection surfaces and controlling the grinding process as a function of the determined dimensions during the grinding process, and using the lowest connection surface in the concrete part as a basis point of reference for grinding of other connection surfaces in the same concrete part, (translation pg. 17, lines 5-22).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 33, 34 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over DE 19753705 in view of Feisel.

DE 19753705 teaches all the limitations of the claims except for the grooved roller being formed in part of silicon carbide and having a diameter of between about 400 and 700 mm, and the grooved roller being disposed on a steel shaft. Feisel teaches a grooved roller made of silicon carbide, (col. 2, lines 55-58). It would have been obvious to one having ordinary skill in the art at the time the invention was made, to provide the method of DE 19753705 with a silicon carbide roller, as taught by Feisel, in order to enhance the rollers grinding capabilities, it would have been further obvious to provide the roller on a steel shaft, and with a diameter of between 400 and 700, in order to enhance the grinding capabilities, and since it is a know fact to fabricate

abrasive roller or wheels on a steel shaft or spindle, and since it has been held that where the general conditions of a claim is disclosed in the prior art, discovering the optimum or workable range involves only routine skill in the art.

#### **(10) Response to Argument**

In reference to independent claim 21, the Applicant argues that the grooved roller must have a cross-section profile that corresponds to the precise shape of the connection system, and that the production device of claim 32 call for a grinding machine with a groove roller configure to grind functionally relevant connection surfaces into the prefabricated concrete part for connection of add on elements. The Applicant further argues that there is an improper interpretation of, "the add on elements of the fixed track", in reference to DE '705. The Applicant states that the DE '705 reference teaches grooves that are milled into concrete plates used to produce a fixed track and that the grooves serve to receive elastically deformable profile elements, which in turn receive the rails of the fixed track. The Applicant also states that the roller, 30, or DE '705 does not have a grooved cross-section profile that corresponds to the desired profile and exact tolerance of a connection surface on the concrete plate, and at best the roller has a profile corresponding to a groove having dimensions to receive an elastically deformable element.

The Examiner disagrees. The Examiner notes that no specific shape of the connection surface has been claimed. Also, both claims 21 and 32 claim using a grooved roller to grind connection surfaces to a desired dimension for, "add on

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elements". The Examiner has interpreted these claims to mean that a grooved roller is used to grind a groove in the concrete, and then the "add on elements" are placed in this groove. The claim calls for the roller to have a cross-sectional profile corresponding to the shape of the connection surfaces, the claims states that the connection surface is the what is ground by the grooved roller for the addition of the "add on elements", but no shape or dimensions of the connection surfaces have been claimed, and neither has a true definition of the "add on elements" been defined. As the Examiner noted in the previous action, the "add on elements" are being interpreted to mean anything added into the grooved concrete, ground by the roller, for the insertion of the fixed track. The DE '705 reference teaches a roller, which is used to grind a groove into concrete, and then adding an elastic element, along with the track, and therefore the "add on element" is considered to be the elastic element along with the rail. The Applicant states that, "the DE '705 teaches a roller having a profile corresponding to a groove having a dimension to receive an elastically deformable element". Therefore, since the Examiner has stated that the interpretation of the "add on element", of the DE '705 reference is considered to be the elastic element along with the fixed track, then the DE '705 reference meets the limitations of the claims.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,

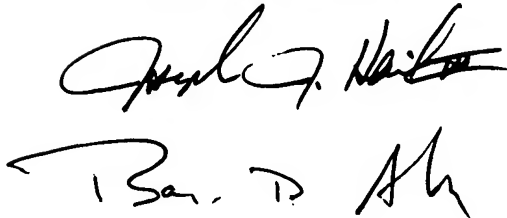
Shantese Lashawn McDonald

Joseph J. Hail, III  
Supervisory Patent Examiner  
Technology Center 3700

Conferees:

Joseph Hail

Boyer Ashley

The block contains two handwritten signatures. The top signature is in cursive and appears to read 'Joseph J. Hail, III'. The bottom signature is also in cursive and appears to read 'Boyer Ashley'.